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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/172,533	10/14/1998	MARTIN T. GOOSEY	50278	9415

7590 11/06/2002
PETER F CORLESS
P O BOX 556
MARLBOROUGH, MA 01752

EXAMINER

TALBOT, BRIAN K

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/172,533

Applicant(s)

GOOSEY ET AL.

Examiner

Brian K Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2 and 5-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The amendment filed 9/3/02 has been considered and entered. Claims 3 and 4 have been canceled. Claims 1,2 and 5-34 remain in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1,2,5,7-17 and 28,29,32 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Giesecke (4,568,570) or Matuzaki et al. (4,734,299).

Giesecke (4,568,570) or Matuzaki et al. (4,734,299) both teach applying a aqueous activating solution which can comprise silver onto a substrate, reducing the activator and electroless plating to form the conductive lines.

Claim Rejections - 35 USC § 103

4. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giesecke (4,568,570) or Matuzaki et al. (4,734,299).

Giesecke (4,568,570) or Matuzaki et al. (4,734,299) fail to teach silver (II) as the activating metal.

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With respect to the use of silver II v. silver I, it is the Examiner's position that one skilled in the art would have had a reasonable expectation of achieving similar success regardless of the valence of the catalytic silver as long as the silver is reduced to a zero valence state, i.e. metallic, so as to achieve a catalytic state. If applicant were to provide a showing that one skilled in the art would not achieve this results, i.e. comparing silver II v. silver I, the Examiner will reconsider his position.

Claims 6,23-27,30,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giesecke (4,568,570) or Matuzaki et al. (4,734,299) in combination with Kunzig (4,298,636) or Feldstein (4,321,285).

Giesecke (4,568,570) or Matuzaki et al. (4,734,299) fail to teach other activating metals such as cobalt, ruthenium, etc.

Kunzig (4,298,636) or Feldstein (4,321,285) both teach alternative metal utilized for activating substrate for electroless plating which include cobalt, ruthenium, rhodium, etc.

Therefore, it would have been obvious for one skilled in the art at the time the invention was made to have modified Giesecke (4,568,570) or Matuzaki et al. (4,734,299) process by incorporating the activating metals as detailed in Kunzig (4,298,636) or Feldstein (4,321,285) because of the expectation of achieving similar results.

Response to Amendment

5. Applicant's arguments filed 9/3/02 have been fully considered but they are not persuasive.

Applicant arguments are not commensurate in scope with the arguments. Applicant argues that the prior art fails to teach the specific activator (silver II) while only claims 18-22 require the silver (II). Furthermore, the Examiner has taken the position that the use of silver II or silver I would produce similar results which one skilled in the art at the time the invention was made would have had a reasonable expectation of achieving success. Applicant has not refuted the Examiner's position with evidence to the contrary.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Tuesday-Friday 6AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 872-9765 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.

A handwritten signature in black ink, appearing to read "B-K Talbot", with a stylized flourish at the end.

Brian K Talbot
Primary Examiner
Art Unit 1762

BKT

November 5, 2002